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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,802	04/13/2004	Junichi Iijima	1081.1199	3060

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EXAMINER
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HESS, DANIEL A

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/822,802

Applicant(s)

IIJIMA, JUNICHI

Examiner

Daniel A Hess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-5 and 7-23 is/are rejected.  
7) ☒ Claim(s) 6 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/13/04  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

Acknowledgement is made that the instant application is a continuation of PCT/JP01/09654 filed in Japan on 11/02/2001.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 7, 11-19 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su (US PG Pub No. 2002/0026380).

Re claim 1: Su teaches a system (see summary; [0019]; [0094] to [0096]) wherein a user can access a terminal inside a shopping mall which has a database that stores product information for various products inside a plurality of stores. See notably figure 6; a search box is present. A search for a product would return results from both a

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first store and a second store located in the mall. Figure 8B, ref. 35 is especially indicative of how a user can receive product information from a plurality of stores together, side-by-side, in search results. From paragraphs [0094] and [0095] it is clear that a user could optionally employ an electronic terminal to assist in locating products in combination with physical shopping.

Su fails to teach that the terminal is located in the first store. However, a computer system could easily have been moved around at the time of the invention to be located inside a particular store. Computers tracking product data inside stores have been well-known. One would have been motivated to move the computer system of Su into a store for customer convenience and to draw customers into the store.

(The examiner wishes to add to the record that there are also systems, some of which certainly predate the instant invention, such as at Home Depot, Circuit City, and Best Buy, which enable a shopper to search – at a terminal inside a store - for products in a large database that includes not only the present store but many other members of the franchise.)

Re claims 2/3: See figure 8B, ref. 735: A list of results includes several different commodities together, with an image of each and background information including price, store, and brand. For a further description of the information that is included with each product, see [0064].

Re claims 4/5: See figure 6, ref. 465: Coupons are available generally, applicable to both a first store and a second store, depending on whether the product is associated with the first store or the second store.

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Re claim 7: Coupons (figure 6, reference 465) are provided to the user. If a coupon is created at a terminal, there must be a way to communicate this discount information to a store at which the associated product is located.

Re claim 11: The printing of the coupon is not explicitly recited.

Printing of coupons from a terminal is an old and well known practice that is exemplified in areas such as at supermarket checkouts, where coupons have long been printed at cash registers.

In view of well-known practice at cash registers, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known printing of coupons such as those shown in figure 6 of Su because this enables the customer to use the coupon at any time or transfer it to another person without elaborate computer information exchange.

Re claim 12: See figure 8B, ref. 740: A purchase can be made locally from the terminal. As per claim 1 above, that terminal may be located inside a first store.

Re claim 13: See discussion re claim 11: printing coupons on receipts has long been a common practice in the art, in order to encourage future sales.

Re claim 14: See discussion re claims 1 and 2, above. An acquisition section corresponds to a search function that returns a first product from a first store along with a second product from a second store.

Re claim 15: Su employs [0014] a client/server system, wherein a user accesses on a client data which is stored on a server. A communication line is necessary.

Re claim 16: This claim is similar to claim 4, which has been discussed above.

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Re claim 17: This claim essentially captures the method of claim 1, discussed above.

Re claim 18: This claim is similar to claim 4, which has been discussed above.

Re claim 19: This claim is similar to claim 7, which has been discussed above.

Re claim 21: This claim recites that there are program instructions essentially forming the sales system recited in claim 1 above. It is inherent that the system of Su operates based on program instructions.

Re claims 22 and 23: These claims are similar to claims 15 and 4, respectively, which have been discussed above.

Claims 8-10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su as applied to claim 1 above, in view of Bezos et al. (US 6,029,141).

These claims essentially deal with the conveyance of commissions based on referrals made by at a first location to a second store. Su fails to teach the conveyance of commissions.

Bezos et al. of Amazon.com teaches (entire document) that commissions are paid to an electronic system (in that case a website) which generates sales for a particular online store. It is to be noted that for at least four years, Amazon.com has referred users to other partner stores for products it does not carry as well.

In view of Bezos' and Amazon.com's teachings, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known conveyance of commissions to a referrer because this will encourage more referrals and thus greater business.

***Allowable Subject Matter***

Claims 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The nearest known prior art of record, Su fails to teach or suggest that, in addition to all limitations from which the claim depends, a discount is applied when the customer purchases at the second store based on a referral from the first store. This is because Su's system is essentially store – neutral.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DH

Daniel A Hess  
Examiner  
Art Unit 2876

**DANIEL STCYR  
PRIMARY EXAMINER**

